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Application Number	09/864,198
Filing Date	May 25, 2001
First Named Inventor	Nicholas H. Des Champs
Art Unit	3635
Examiner Name	Mark A. Fadok
Attorney Docket Number	

ENCLOSURES (Check all that apply)

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Date	May 9, 2005	Reg. No.	33,083

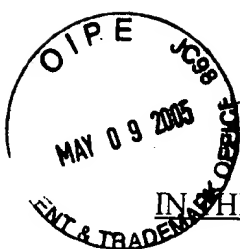
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nicholas H. Des Champs

Appeal No. _____

Serial No.: 09/864,198

Group Art Unit: 3625

Filed: May 25, 2001

Examiner: FADOK, Mark A

For: SCRAP REDUCTION BY COMBINING OPERATIONS OF DIFFERENT
MANUFACTURERS

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REPLY BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Honorable Members of the Board of Patent Appeals and Interferences:

This Reply Brief is in response to the Examiner's Answer mailed April 18, 2005.

The examiner for the first time, in violation of MPEP 706.07(a), in the FINAL REJECTION, introduced the reference to Stewart and made a new grounds of rejection based on Stewart. The only changes made to the original claims were to change inadvertently included periods in claims 11 and 17 to semicolons. In view of this the reasoning advanced by the Examiners Answer is almost all made for the first time and all of the authorities are newly introduced. This Reply Brief addresses these new issues.

Claim Preamble

In the “Examiner’s Answer,” for the first time, the examiner cited as justification for ignoring the preamble, MPEP 2111.02 [R-2], with the collection of citations contained therein. A careful review of the claims and their support found in the specification, and a review of the prior art references to Stewart make it clear that your applicant’s interpretation of the claims and the law were accurate.

The claim preamble is a necessary and appropriate part of the claim. Those cases that relate to structure and/or a product are irrelevant as the claims are drawn to a process. The citations that do address process claims affirm your applicant’s interpretation of patent law.

The claim preamble is not relied on to supply structure limitations in an article or apparatus or to merely set forth a purpose or use for the “structure” claimed as addressed in the examiner’s Corning Glass Works and Pitney Bowes and Rowe and Krops and STXLLC and Schreiber cites found in MPEP 2111.02.

However, the examiner’s cites addressing process claims, as presently under consideration, are pertinent and confirm your applicant’s original contentions regarding the present preamble. The preamble is a statement of the intentional purpose for which the method must be performed and addresses a manipulative difference as Jansen and Cruciferous in MPEP 2111.02 clearly indicate to be proper claim limitations.

Art Rejection

The prior art applied does not address either the problem or its solution. The examiner's perceptions are not a substitute for facts found in the art of record.

The problem is disclosed in the present application (page 2, line 14 through page 3, line 16). The favored way to preclude scrap is to perform the second party cutting operation before the blank cut by the first party is removed from the machine. The solution to the problem is summarized in the paragraph sharing pages 4 and 5.

The examiner asserts, in the paragraph sharing pages 5 and 6 of his answer, that only knowledge which was within the level of ordinary skill at the time the invention was made has been applied in rejecting the claims citing In re McLaughlin. Your applicant challenges such blatant ignoring of the present declaration and specification and claims. The appropriate action and response necessary to such a challenge, on the part of the examiner, is to support his allegations of obviousness with factual documentation. As with the Official Notice taken with Abhyanker in the first Office Action where a 35 USC 102(e) rejection of claims 1- 4, 7 -11, 14 and 15 was made based on Abhyanker (2002/0133416) and a 35 USC 103(a) rejection of claims 5, 6, 12, 13, 16 and 17 was made based on Abhyanker in view of Official Notice, the examiner is avoiding his duty to properly examine the claims, the examiner refuses to acknowledge the importance and relevance of the challenge even though specific details are recited in the claims that also have been ignored.

The proper criteria for claim rejection has not been followed and the limited use of Official Notice has been ignored. The only way the examiner can possibly find the claimed steps and concepts is to glean them from the specification, i.e. by hindsight. Simply choosing to ignore them is not a proper substitution for prior art teachings. The taking of official notice here is no more than a personal opinion and is not a substitute for evidence in the record. The courts have strongly rejected this type rejection to avoid the burden of proof required by 35 USC 103. The examiner has not complied with:

a) The requirement for rejections, set forth by the Supreme Court in Graham v. John Deere, 148 USPQ 459 (1966), has not been properly complied with.

b) The examiner has misconstrued the prior art and provided no sound reasoning why one working in the art would modify the art to solve a problem the prior art does not address.

c) The use of Official Notice has not been limited as required by MPEP 2144.03.

d) The examiner has not rejected the claims based on facts of record, as required.

a) The pertinent primary inquiries in determining obviousness under Section 103 are set forth in the Supreme Court's decision in Graham v. John Deere. The primary considerations set forth therein require (1) determination of the scope and content of the prior art; (2) identification as to the differences between the prior art and the claims at issue; and (3) resolution of the level of ordinary skill in the pertinent art. For the Examiner to assign attributes to the references which do not, in fact, exist and to entirely discount the critical language within the claims which is directed to Applicant's combination of steps does not comply with the Graham requirement of objectively identifying the differences between the claimed invention and the prior art.

b) The examiner has mischaracterized what the prior art teaches. The examiner has provided no sound reasoning as to why one working in the art would modify the prior art to solve a problem the prior art does not address. In re Gordon, 221 USPQ 1125 (Fed.Cir. 1984). Stanley Works v. McKinney Mfg, 216 USPQ 298 (Del. D.C. 1981). The prior art must address and provide the inventors answer to the particular problem confronting the examiner. In re Winslow, 151 USPQ 48 (CCPA 1966). The prior art does not do this.

c) The Official Notice taken does not comply with MPEP 2144.03. The notice is not to be appropriate as to “facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known.” The circumstances for applying this criteria are not present. The notice does not “plug in” a common procedure, it creates a procedure to modify a procedure never disclosed by the prior art.

d) In addition to the previously set forth law (Brief page 11) as set forth in In re Soli, and In re Wagner et al, and In re Wood and Everrode and In re Zwerko; it is noted that in a more recent decision the Board of Appeals held that it was not necessary to present a source of teaching, suggestion, or motivation to combine references as obviousness can be concluded from common knowledge or common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. The Federal Circuit vacated the Board’s decision for failure to meet adjudicative standards. The Court held that a showing of a suggestion, teaching, or motivation to combine prior art references is an essential component and this need for specificity pervades precedential authority as teachings of references can be combined only if

there is some suggestion or incentive to do so. In re Sang-Su Lee, No. 00-1158 (Fed. Cir. Jan.18, 2002.) The reading of claim procedures into one reference is no less deserving of prior art teachings than reading them into two references.

The examiner's interpretation of the teachings of Stewart is likewise a personal perverted opinion that is not supported by a reasonable unbiased interpretation of the Stewart disclosure. There is no showing that the examiner's reconstruction opinion today is that which the mechanic would have made at the time the invention was made, or that he, the examiner, in fact, represents a mechanic in the art. There is no affidavit or other showing in the record that qualifies or elevates the examiner's personal opinion to the level of evidence.

The examiner's interpretation of Stewart found on pages 6 - 8 is more an exercise in mental gymnastics than proper claim rejection. The examiner's conclusion that "Stewart clearly teaches the sale of 'potential scrap' ... in a secondary market for lower quality products that could not be sold in the primary markets and could 'potentially' be scrapped" in view of paragraph 0093 of Stewart finds no support in logic or fact insofar as the present invention is concerned. a) A manufacturer who manufactures products that must be scrapped is not preventing or reducing scrap. b) The sale of scrap is not properly in issue, preventing it is. c) The sale of scrap in a "secondary" market is not properly in issue, prevention of scrap is. d) The sale of lower quality products that cannot be sold in a primary market is not properly in issue, there is no provision for or desire to manufacture inferior products. e) The concept that "lower quality products" are potential scrap is a personal opinion and not properly in issue. f) The fact the "product never

becomes scrap then it is a salable product” is irrelevant and not properly an issue. The fact the inventor wants to sell all the material and have no scrap is relevant, but the invention is in the procedure employed for eliminating as much scrap as possible. g) Selling excess inventory is not properly in issue. If reducing the amount of scrap from a sheet is “inventory,” all the inventory is taken before anything is manufactured.

The simple procedural scrap prevention issue has been misconstrued and oversimplified in that the Stewart reference has been interpreted to address a problem and solve it in a manner never intended or suggested by Stewart.

The examiner’s concluding paragraph (sharing pages 8 and 9 of the Examiner’s Answer) contains irrelevant and quite misleading implications. (1) The examiner’s reference does not fail to show features. (2) The reduction of the first manufacturer’s scrap does not define who or what entity is receiving the benefit of the scrap reduction. (3) The claims are interpreted in light of the specification but will not have limitations from the specification read into the claims with Van Geuns cited.

(1) Claim 1 specifically requires that there be a repository for materials, sizes, and thicknesses available by a first party and a repository for materials, sizes and thicknesses needed by second parties with the needs communicated to each other. Stewart does not disclose “features” or render obvious such information collection called for and communications provided between parties. The information permits scrap reduction by a first manufacturer making parts for a second manufacturer.

(2) The benefactor of the scrap reduction is irrelevant but the specification makes it clear that both parties benefit. (Specification pages 4 lines 14 and 15, for example.)

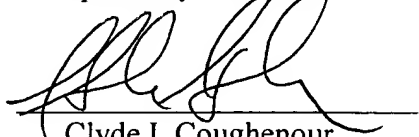
(3) The problem with the rejection is not a need to transfer limitations from the specification into the claims; it is the ignoring of claim limitations combined with reading non-existent limitations, procedures and objectives, into the Stewart reference. The claims involve a process that is more involved than simply selling different quality products on the open market.

The rejection is based on an irrelevant reference modified by hindsight and an overactive imagination.

CONCLUSION

The Examiner's rejection of claims 1-17 is based on erroneous personal opinion and not facts of record or steps taught by Stewart. The rejection of claims 1- 17 should be reversed and such action is earnestly solicited.

Respectfully submitted



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